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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,075	06/29/2006	Shinnichiro Yamauchi	061282-0205	6209
53080 7590 01/04/2010 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, NW WASHINGTON, DC 20005-3096				
EXAMINER				
KING, CURTIS J				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/585,075

**Applicant(s)**

YAMAUCHI, SHINNICHIRO

**Examiner**

Curtis J. King

**Art Unit**

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 29 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/22)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. Figures 1-8 and 23 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The abstract of the disclosure is objected to because the abstract should be a single paragraph. Correction is required. See MPEP § 608.01(b).
3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: COMMUNICATION SYSTEM/METHOD THAT PROVIDES AUTHENTICATION UPDATES TO COMMUNICATION DEVICES.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-3, 9-10 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claim 2 recites the limitation "the specific communication machine" in line 2 of claim 2. There is insufficient antecedent basis for this limitation in the claim.

2) Claim 9 recites the limitation "the communicating party" in lines 2-3 of claim 9. There is insufficient antecedent basis for this limitation in the claim.

3) Claims 10 and 15 contains the trademark/trade name BLUETOOTH. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe short-range radio enabled communication and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4, 7-11, and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi (PG-Pub. No. 2003/0061518 A1).

1) In regard to claim 1, Yamaguchi discloses the claimed, communication system having an authentication function using authentication information and enabling communications to be conducted at least between two communication machines (¶0001), the communication system comprising:

a communication section (fig. 1: 20 discloses as an Authentication management unit) for wirelessly supplying the authentication information to at least one of the at least two communication machines (fig. 1 and ¶0061 discloses the Authentication management unit supplying a key (i.e., authentication information) to each device so that communication may be conducted between the devices).

2) In regard to claim 4 (dependent on claim 1), Yamaguchi further discloses the communication system according to claim 1, wherein the communication section is installed separately from the at least two communication machines (fig. 1 shows the Authentication management unit separate from each device).

3) In regard to claim 7 (dependent on claim 1), Yamaguchi further discloses the communication system according to claim 1, wherein the at least one communication machine comprises:

a function of performing authentication with the communication section using first authentication information uniquely predetermined for each communication machine (¶0069-0071 discloses a request signal is sent to the authentication management unit from the device which has registration information identifying the device); and

a function of performing authentication between the at least two communication machines using second authentication information different from the first authentication information (¶0100 discloses a common key is generated for communication between the devices used for authentication between the devices).

4) In regard to claim 8 (dependent on claim 1), Yamaguchi further discloses the communication system according to claim 1, wherein the authentication information includes:

fixed authentication information predetermined for each communication machine and used between the communication section and the at least one communication machine (¶0100-0101 discloses a master key is created corresponding to the request signal received from the device which is used for communication between the authentication management unit and the device); and

variable authentication information generated arbitrarily and used for communications between the at least two communication machines (¶0100 discloses a

common key is generated to be used for communication between the devices, and ¶0102 discloses the common key is generated regularly).

5) In regard to claim 9 (dependent on claim 1), Yamaguchi further discloses the communication system according to claim 1, wherein the authentication information is address information or password information of the communicating party (¶0061 discloses master key M is the authentication communication key needed in order for the device 10 a/b to communicate with the authentication device).

6) In regard to claim 10 (dependent on claim 1), Yamaguchi further discloses the communication system according to claim 1 the communications between the at least two communication machines or communications between the at least one communication machine and the communication section are wireless communications conforming to Bluetooth standard (¶0108).

7) In regard to claim 11, claim 11 is rejected with respect to claim 1 the system claim.

8) In regard to claims 13 and 14 (dependent on claim 11 and 13 respectively), claims 13 and 14 are rejected with respect to claim 7 the system claim.

9) In regard to claim 15 (dependent on claim 11), claim 15 is rejected with respect to claim 10 the system claim.

10) In regard to claim 16, claim 16 is rejected with respect to claims 7 and 8 the system claims.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-3, 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi (PG-Pub. No. 2003/0061518 A1) in view of Famolari (PG-Pub. No. 2003/0110484 A1).

1) In regard to claim 2 (dependent on claim 1), Yamaguchi discloses the communication system according to claim 1.

Yamaguchi does not disclose the communication section is installed in the specific communication machine of the at least two communication machines.

Famolari discloses a communication section is installed in the specific communication machine of the at least two communication machines (¶¶0016-0017 discloses a handheld Bluetooth device that has a communication section installed in it to supply updated software to the other Bluetooth devices 11-14).



It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify Yamaguchi communication system by installing the communication section into one of the communication devices as taught by Famolari for the predictable result of having a central device to distribute authentication information.

The motivation would be to add an additional feature to the system in which would provide the flexibility of modifying existing applications or to add new applications to a device.

2) In regard to claim 3 (dependent on claim 2), Yamaguchi in view of Famolari further disclose the communication system according to claim 2, wherein the communication section installed in the specific communication machine supplies the authentication information to the communication machine other than the specific communication machine, of the at least two communication machines (fig. 1 and ¶0016-0017 discloses updated information is supplied to Bluetooth devices 11-14 from handheld Bluetooth device 31).

3) In regard to claim 5 (dependent on claim 1), Yamaguchi discloses the communication system according to claim 1.

Yamaguchi does not disclose the communication section comprises an external interface and receives the authentication information via the external interface.

Famolari discloses a communication section (fig. 4: 56 discloses as Bluetooth access point) comprises an external interface (fig. 4: 59) and receives the authentication information via the external interface (¶0025 discloses the access point downloads updates through Bluetooth interface 59).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify Yamaguchi communication system with the inclusion of an external interface, as taught by Famolari.

The motivation would be to provide an additional feature to the device in which would allow new information to be downloaded from devices that do not have a network connection with the device.

4) In regard to claim 12 (dependent on claim 11), claim 12 is rejected with respect to claim 3 the system claim.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi (PG-Pub. No. 2003/0061518 A1) in view of Famolari (PG-Pub. No. 2003/0110484 A1) and further in view of Hori (PG-Pub. No. 2002/0191764 A1).

1) In regard to claim 6 (dependent on claim 5), Yamaguchi and Famolari discloses the communication system according to claim 5.

Yamaguchi and Famolari do not disclose the communication section receives the authentication information retained on a memory card connected to the external interface via the external interface.

Hori discloses a communication section that receives the authentication information retained on a memory card connected to the external interface via the external interface (¶0081 discloses a mobile phone that has a detachable memory card which may upload authentication information (i.e., encrypted data)).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify Yamaguchi and Famolari communication section with accepting storage devices to be used to update the device, as taught by Hori.

The motivation would be to add an additional feature to the system that would allow the communication section to be updated via a memory card in cases when the wireless network that is used to update the communication section is down.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) Dent (PG-Pub. No. 2002/0178385 A1)

-- Similar inventive concept

2) Haller (PG-Pub. No. 2002/0163895 A1)

-- Similar inventive concept

3) Miyatsu (PG-Pub. No. 2003/0114106 A1)

-- Similar inventive concept

4) Sugikawa (PG-Pub. No. 2004/0092249 A1)

-- Similar inventive concept

5) Yoshimoto (Pat. No. 6,237,023 B1)

-- Memory card used to update authentication server

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis J. King whose telephone number is (571)270-5160. The examiner can normally be reached on Mon-Thurs 7:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin C. Lee can be reached on (571)272-2963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ck/

/BENJAMIN C. LEE/  
Supervisory Patent Examiner, Art Unit 2612